UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,365	09/26/2003	Chris Savarese	06196.P002	3038

7590 06/20/2007

James C. Scheller, Jr.
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER	
BANTA, TRAVIS R	

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
06/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/672,365	SAVARESE ET AL.	
	Examiner	Art Unit	
	Travis R. Banta	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *128-141 and 147-149* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *128-141 and 147-149* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 September 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :September 17, 2004, November 15, 2004, February 2, 2005, June 29, 2005, October 11, 2005, October 14, 2005, and September 11, 2006.

DETAILED ACTION

Response to Amendment

The Applicant elected group IV in response to the restriction requirement. Claims 128-141, 147-149 are pending and treated herein.

Information Disclosure Statement

Several Information Disclosure Statements have been considered and are included herewith. These Information Disclosure Statements show a date of receipt as September 17, 2004, November 15, 2004, February 2, 2005, June 29, 2005, October 11, 2005, October 14, 2005, and September 11, 2006. The Examiner has provided initialed copies of these statements.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are not of sufficient quality because they are sketched by hand or in the case of printed drawings, the printing is too dark in many of the drawings to accurately describe the invention. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 128-141, and 147-149 rejected under 35 U.S.C. 102(e) as being anticipated by Pirritano et al. (US 6,620,057).

Regarding claim 128, Pirritano et al. disclose a system for locating golf balls. In this system, components of a locatable golf ball are described. Specifically, Pirritano et al. discloses a spherical golf ball having several voids, but at least a first and second void on the outer surface of a spherical material. A void is created by passive transponders in the form of flat loop inductors (see column 5 lines 14-15 and figures 2, 3 and 4 item 33). Up to several transponders are placed on the outer surface of the sphere creating a void of ball material (see column 11 lines 5-7, column 5 lines 12-14). A cover is affixed to the golf ball thereafter to make the golf ball usable for general play. The voids created by the insertion of the golf ball transponders are generally circular in nature (see column 5 line 20) and are disclosed to be "oppositely facing flat faces" (see column 5 line 21-22). It is therefore inherent that an axial line can be drawn through the centers of each transponder, and thereby, each void. If the transponder faces are opposite each other in a sphere, there must necessarily be an axial line describing two poles having a void (created by the transponder) on each end of the axial line.

Regarding claim 129, Pirritano et al. discloses a shell that encloses the ball core (see column 11 lines 7-9 "ball jacket").

Regarding claim 147, Pirritano et al. discloses that a first and second electrical component are disposed respectively in first and second voids inside a golf ball (see rejection of claim 128).

Regarding claim 148, Pirritano et al. discloses a spherical material having a first void on an outer surface (see column 5 lines 14-15, and figures 2, 3, and 4 item 33). A first electrical component is disposed within the void (a passive transponder). The void is created by the transponder to fit the transponder inside the golf ball. Lamination (see column 5 lines 30) is used to affix the transponder to the ball in the void. Lamination is well known in the art to bond materials using heat or pressure, and an adhesive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 130-131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pirritano et al. (US 6,620,057).

Regarding claim 130, Pirritano et al. discloses several passive transponders inside the golf ball with antennas disposed at 90 degrees to each other (see claim 1). Pirritano et al. does not specifically disclose the transponders are semi-conductors

though on column 5 lines 36-37 it is disclosed that the transponders can be made of vapor deposited metal, or any other conductive material which is capable of being formed into a thin foil or film. One of ordinary skill in the art would recognize that a semiconductor circuit made to mimic the wavelength and other properties of the transponders would be advantageous because of a more durable packaging and excluding the use of expensive KAPTON. One of ordinary skill in the art would be motivated to use an integrated circuit passive transponder to increase the durability of the ball with decreased expense. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to use semiconductor chips instead of passive foil transponders.

Regarding claim 131, Pirritano et al. discloses transponders. A semiconductor is deemed to be obvious as described above. The transponders disclosed are interpreted to be equivalent to RFID circuitry. Pirritano et al. refers to the transponders also as tags in column 17. RFID tags are well known in the art. The transponders tags and RFID tags are therefore deemed to be equivalent.

Regarding claim 132, Pirritano et al. discloses a golf ball component with a tag (column 17) is detectable with a hand held transmit/receive device over a range of up to 300 feet (see column 11 lines 12-17). Pirritano discloses the ball to have high durability (see column 13 line 18). Pirritano et al. fails to disclose the golf ball in compliance with the specifications of the United States Golf Association (USGA). However, one of ordinary skill in the art would recognize that golf balls that were not in compliance with commonly accepted standards would be useless for improvements in golfing ability

because a player could not use non-standard balls in a tournament or competition. One of ordinary skill in the art would be motivated to make the golf balls disclosed by Pirritano et al. to be in compliance with the USGA specifications to make the balls legal for tournament play and "fair" by commonly accepted standards. It would therefore be obvious to one ordinary skill in the art at the time of the invention to incorporate the standards for USGA golf balls into the golf balls of Pirritano et al..

Regarding claim 133, Pirritano et al. discloses the antennas to be disposed on an outer "form" understood by the Examiner to be the core material on the inside of the shell (see column 13 lines 16-18). Pirritano et al. also discloses that the frequency at which the ball re-radiates an RF signal can be a frequency other than the "illuminating" frequency (see column 10 line 61- column 11 line 4).

Regarding claim 134, Pirritano et al. discloses the antenna is made of copper. The Examiner could find no definition in the Applicant's specification as to what an elastic conductive material is. Only that an elastic conductive ink or a polymer with metal particles could satisfy. The Examiner has determined copper to satisfy as an elastic material due to its ability to bend and un-bend to return to its original state. Copper is well known in the art to be conductive.

Regarding claim 135, Pirritano et al. discloses lamination for affixing at least a first and second transponder to the golf ball core. Lamination is well known in the art to bond materials with an adhesive.

Regarding claim 136, Pirritano et al. discloses a spherical core having a first void on an outer surface (see figures 2,3, and 4). Pirritano et al. also discloses affixing a first

semiconductor to the core creating a void with an adhesive material (lamination). Pirritano et al. does not disclose a semiconductor disposed in the void. Pirritano et al. does not specifically disclose the transponders are semi-conductors though on column 5 lines 36-37 it is disclosed that the transponders can be made of vapor deposited metal, or any other conductive material which is capable of being formed into a thin foil or film. One of ordinary skill in the art would recognize that a semiconductor circuit made to mimic the wavelength and other properties of the transponders would be advantageous because of a more durable packaging and excluding the use of expensive KAPTON. One of ordinary skill in the art would be motivated to use an integrated circuit passive transponder to increase the durability of the ball with decreased expense. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to use semiconductor chips instead of passive foil transponders.

Regarding claim 137 and 138, Pirritano et al. discloses transponders. A semiconductor is deemed to be obvious as described above. The transponders disclosed are interpreted to be equivalent to RFID circuitry. Pirritano et al. refers to the transponders also as tags in column 17. RFID tags are well known in the art. The transponders tags and RFID tags are therefore deemed to be equivalent.

Regarding claim 139, Pirritano et al. discloses a golf ball component with a tag (column 17) is detectable with a hand held transmit/receive device over a range of up to 300 feet (see column 11 lines 12-17). Pirritano discloses the ball to have high durability (see column 13 line 18). Pirritano et al. fails to disclose the golf ball in compliance with

the specifications of the United States Golf Association (USGA). However, one of ordinary skill in the art would recognize that golf balls that were not in compliance with commonly accepted standards would be useless for improvements in golfing ability because a player could not use non-standard balls in a tournament or competition. One of ordinary skill in the art would be motivated to make the golf balls disclosed by Pirritano et al. to be in compliance with the USGA specifications to make the balls legal for tournament play and "fair" by commonly accepted standards. It would therefore be obvious to one ordinary skill in the art at the time of the invention to incorporate the standards for USGA golf balls into the golf balls of Pirritano et al..

Regarding claim 140, Pirritano et al. discloses the antenna is made of copper. The Examiner could find no definition in the Applicant's specification as to what an elastic conductive material is. Only that an elastic conductive ink or a polymer with metal particles could satisfy. The Examiner has determined copper to satisfy as an elastic material due to its ability to bend and un-bend to return to its original state. Copper is well known in the art to be conductive.

Regarding claim 141, Pirritano et al. discloses several passive transponders inside the golf ball with radial transmission lines disposed at 90 degrees to each other (see claim 1). An antenna and a radial transmission line are determined to be equivalent. Pirritano et al. does not specifically disclose the transponders are semi-conductors though on column 5 lines 36-37 it is disclosed that the transponders can be made of vapor deposited metal, or any other conductive material which is capable of being formed into a thin foil or film. One of ordinary skill in the art would recognize that

a semiconductor circuit made to mimic the wavelength and other properties of the transponders would be advantageous because of a more durable packaging and excluding the use of expensive KAPTON. One of ordinary skill in the art would be motivated to use an integrated circuit passive transponder to increase the durability of the ball with decreased expense. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to use semiconductor chips instead of passive foil transponders.

Regarding claim 149, A semiconductor is deemed to be obvious as described above. The transponders disclosed are interpreted to be equivalent to RFID circuitry. Pirritano et al. refers to the transponders also as tags in column 17. RFID tags are well known in the art. The transponders tags and RFID tags are therefore deemed to be equivalent.

Conclusion

The following prior art though not relied upon is deemed to be pertinent to the applicant's disclosure.

USPGPUB 20020177490 – Radio Frequency Identification system for Golf Balls.

USPN 5910057 – Golf Ball with Distance and Locating System

USPN 5743815 – Golf Ball identification system.

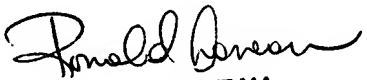
USPN 5626531 – Golf Ball with tag and detecting system

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis R. Banta whose telephone number is (571) 272-1615. The examiner can normally be reached on Monday-Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TB



RONALD LANEAU
PRIMARY EXAMINER

5|23|07